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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/894,928

06/28/2001

Andrew Ferlitsch

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7053

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7590

03/15/2006

KRIEGER INTELLECTUAL PROPERTY, INC.

P.O. BOX 1073

CAMAS, WA 98607

EXAMINER

QIN, YIXING

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/894,928

Applicant(s)

FERLITSCH, ANDREW

Examiner

Yixing Qin

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

In response to applicant's amendment received 12/12/05, all requested changes have been entered.

### ***Response to Arguments***

Applicant's arguments, 12/12/05, have been fully considered and are persuasive. The Examiner notes that the previously cited Blossey reference does not disclose the user manipulation of an index file after the creation of the file. The Examiner also notes the other amendments made to the various dependent claims. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kawamoto. The Examiner believes the Kawamoto reference suggests the limitations of all the current claims because it discloses an invention where a driver is used to create an page-by-page index file for a print job, and uses this index in the processing of the print job at a printer. Please see the new rejection below.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows:

Claim 20 define a "signal" embodied in an electronic transmission with functional descriptive material. While functional descriptive material may be claimed as a statutory

product (i.e., a “manufacture”) when embodied on a tangible computer readable medium, a “signal” per se does not fall within any of the four statutory classes of 35 U.S.C. §101. A “signal” is not a process because it is not a series of steps per se. Furthermore, a “signal” is not a “machine”, “composition of matter” or a “manufacture” because these statutory classes “relate to structural entities and can be grouped as ‘product’ claims in order to contrast them with process claims.” 1 D. Chisum, Patents § 1.02 (1994). Machines, manufactures and compositions of matter are embodied by physical structures or material, whereas a “signal” has neither a physical structure nor a tangible material. That is, a “signal” is not a “machine” because it has no physical structure, and does not perform any useful, concrete and tangible result. Likewise, a “signal” is not a “composition of matter” because it is not “matter”, but rather a form of energy. Finally, a “signal” is not a “manufacture” because all traditional definitions of a “manufacture” have required some form of physical structure, which a claimed signal does not have. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

I. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamoto (U.S. Patent No. 6,172,765).

**1. Claims 1, 10, 14, 18, 19 and 20**

- Kawamoto discloses in column 4, line 33 the creation of a document and the conversion of the document to print data (i.e. **spool data file**).
- Kawamoto discloses in Fig. 5 and column 5, lines 15-38 the generation of an job index file (i.e. **PISF**) using page by page extracted data from the file.
- In embodiment 6, Fig. 20 of Kawamoto, there is a prompt asking an user whether to continue a print job and continue with a resolution or tone reduction (i.e. allows **user manipulation after creation of index file**). Column 16, lines 40-67 and column 17, lines 1-14 explains in detail the process that takes place.

Art Unit: 2622

- Also note in column 11, lines 23-26 that a command "ESC>[\$\$\$<ESC>[###" is inserted at an area before a new page code (the insertion is due to the user manipulation of clicking the yes button as discussed above). Fig. 12 is an extension of Fig. 7 with since it includes the addition of this command. See in Fig. 7 and column 6, lines 4-6 that the job index file 701 is inserted at the beginning of the file. Although it is not explicitly stated that this inserted command is part of the index file, it would be obvious to one of ordinary skill in the art that this would be the case since the index file is used to tell a printer how to print a certain document.
- The examiner would also like to point out Fig. 14A, which is a driver that handles the creation and manipulation of an index file.

**2. Claim 2**

- Kawamoto does not explicitly disclose the type of the file used. However, typical files format such as EMF and raw data are known to be used (as explained by the applicant disclosed prior art in the background of the specification on pg 3, lines 19-21). It would be obvious for Kawamoto's invention to use a common format for compatibility purposes

**3. Claim 3**

- Kawamoto discloses in Fig. 5 individual records of each page.

**4. Claim 4**

- One can see in Fig. 20 that there is an interface that a user can use to acknowledge resolution or tone modification.

**5. Claims 5 and 8**

- Kawamoto discloses in Fig. 3 that a generating unit creates an index from the spooled document file (file 38). (column 5, lines 31-34). The document file, as mentioned above, is created by a personal computer.

**6. Claim 6**

- Kawamoto discloses in Fig. 14A the programs for a modified print driver.

**7. Claim 7**

- Kawamoto discloses in column 5, lines 53-67 discloses that the job and page index files have been stored in RAM 23. This is before the job/page index file and the print data has been combined, so they would indeed be stored independently of each other.

**8. Claim 9**

- Although not explicitly disclosed, the idea of collation is well known in the printing environment and would be obvious to one of ordinary skill to include additional

Art Unit: 2622

output manipulation such as collation (or stapling, duplexing, etc.) functions to Kawamoto's invention.

**9. Claims 11-13, 15-17**

- Again, the disclosed print driver in Fig. 14A of Kawamoto performs the manipulation and accessing. This driver can read on a number of items, since it can process, retain data (i.e. similar to a function of a spooler), and assistant between the computer and a printer.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

Art Unit: 2622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ

*KA Williams*

**KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER**